

**REMARKS/ARGUMENTS**

This application has been reviewed in light of the Office Action mailed on October 29, 2007. Claims 1-17 are pending in the application with claims 1 and 8 amended herein and being in independent form. In view of the following amendments and/or remarks, reconsideration and allowance of this application are respectfully requested.

**Claim Rejection – 35 U.S.C. §103**

The Examiner has rejected claims 1-17 under 35 U.S.C. § 103 (a) as being unpatentable over commonly owned U.S. Patent No. 5,573,534 to Stone (hereinafter simply referred to as Stone) in view of Francese et al. (U.S. Patent No. 5,722,421) (hereinafter simply referred to as Francese) and Klieman et al. (U.S. Patent No. 5,827,323) (hereinafter simply referred to as Klieman). Applicants respectfully traverse the rejection and respectfully submit that Stone, Francese, or Klieman do not render claims 1-17 unpatentable for at least the following reasons.

According to § 2143.03 of the MPEP, “[t]o establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.” It is Applicants’ position, that all the claim limitations of amended independent claims 1 and 8, of the above-referenced application, are not taught or suggested, either expressly or implicitly, by any of the above cited art of record either taken alone or in any conceivable working combination.

As noted in the present Office Action, the Examiner avers that “Stone discloses the claimed device except for a stop disposed adjacent to at least one of the sealing

surfaces for maintaining a separation distance..." Although not disclosed in Stone, the Examiner avers that Francese teaches the stop configured in a manner as recited in claims 1 and 8.

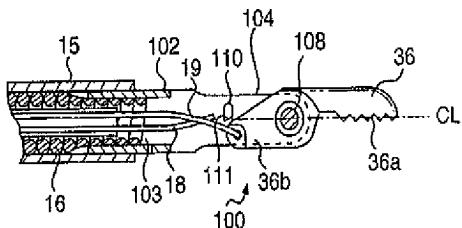
While Applicants acknowledge that Francese does disclose the use of a pair stops, Applicants respectfully submit that modifying the bipolar instrument disclosed in Stone with the pair of stops disclosed in Francese does not render amended claims 1 or 8 unpatentable.

As amended herein, claim 1 recites, "[a] laparoscopic bipolar electrosurgical instrument for sealing tissue", including, *inter alia*, "[...] a stop for maintaining a minimum separation distance of at least about 0.03 millimeters between opposable sealing surfaces, the stop being located distally relative to the pivot [...]"

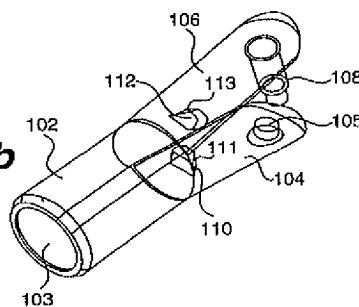
Similarly, claim 8 recites "[a] laparoscopic bipolar electrosurgical instrument for sealing tissue", including, *inter alia*, "[...] a stop disposed on one of the opposable sealing surfaces for maintaining a minimum separation distance between the opposable sealing surfaces, the stop being located distally relative to the pivot [...]"

Francese discloses, "a clevis axle 108 which extends between the distal ends of the clevis arms, and a pair of stops 110, 112, which extend inward from the inner surfaces of the clevis arms at a location proximal the axle 108 (emphasis added). See col. 4, lines 49-53 and FIGS. 8 and 8b below.

**FIG. 8**



**FIG. 8b**



As can be clearly seen in the above FIGS., jaws 36 and 38 each are rotatably mounted on a clevis 104 and are allowed to pivot by way of clevis axle 108. Emphasis should once again be drawn to the location of the stops 110 and 112 relative to the point of pivot about axle 108. That is, the stops 110 and 112 are located at a point which is proximal to the axle 108. It should be noted that having the stops 110 and 112 configured in such a manner serves a specific purpose. As described in Francese, "[t]he stops are dimensioned and located to engage respective tangs of a pair of jaws, which are mounted on the axle, when the jaws are rotated about the axle to a point of deflection." See col. 3, lines 14-17. In this instance, the pair of stops 110 and 112 are configured to prevent damage to the forceps caused by excessive deflection (e.g., entanglement of the control wires). See col. 2, lines 6-7 and col. 3, lines 5-8.

Nowhere in the Francese reference is it disclosed that the stops 110 and 112 may be located at any place on the forceps other than as indicated above, i.e., at a location other than proximal the pivot point. It is Applicants' position that having the stop located distally relative to the pivot, as recited in claims 1 and 8, is patentably distinguishable from having the stops located proximally to the pivot, as taught by Francese, since the relative distance between the jaw members may be more

accurately controlled along the length of the jaw members which is essential for effective vessel sealing.

Based on the foregoing, Applicants respectfully submit that Francese fails to cure the deficiencies of Stone in that Francese fails to disclose, a stop disposed on one of the opposable sealing surfaces for maintaining a minimum separation distance between the opposable sealing surfaces, the stop being located distally relative to the pivot, as recited for in claims 1 and 8.

Since Stone and/or Francese, taken alone or in any proper combination, do not teach or suggest each and every element as set forth in claims 1 and 8 the rejections of claims 1 and 8 under 35 U.S.C. § 103(a) should be withdrawn.

Since claims 2-7 and 9-17 depend, directly or indirectly, from claims 1 and 8, respectively, and contain all of the features of claims 1 and 8, Applicants respectfully submits that claims 2-7 and 9-17 are also patentable over Stone in view of Francese.

The Examiner relies on Klieman for teaching a means for maintaining a closure force between opposable sealing surfaces **40** and **44**.

Klieman shows a locking mechanism that allows the end effector pieces **40** and **44** to be "clamped" on tissue or closed during a surgical procedure and kept locked in that closed position. See col. 10, lines 13-15. Applicants respectfully submit that Klieman does not cure the deficiencies of Stone in that Klieman fails to disclose, a stop disposed on one of the opposable sealing surfaces for maintaining a minimum separation distance between the opposable sealing surfaces, the stop being located

Appl. No. 10/516,480  
Amendment Dated January 23, 2008  
Reply to Office Action of October 29, 2007

**distally relative to the pivot**, as recited for in claims 1 and 8. Accordingly, Applicants submit that claims 1 and 8 and any claims depending either directly or indirect therefrom, namely, claims 2-7 and 9-17 are allowable under 35 U.S.C. 103 (a) over Stone in view of Francese and in further view of Klieman.

**CONCLUSION**

In view of the foregoing amendments and/or remarks, it is respectfully submitted that all claims presently pending in the application, namely, claims 1-17, are believed to be in condition for allowance.

If the Examiner should have any questions concerning this communication or feels that an interview would be helpful, the Examiner is requested to call the Applicants' undersigned attorney at the Examiner's convenience.

Please charge any deficiency as well as any other fee(s) that may become due under 37 C.F.R. § 1.16 and/or 1.17 at any time during the pendency of this application, or credit any overpayment of such fee(s), to Deposit Account No. 21-0550.

Respectfully submitted,

  
\_\_\_\_\_  
Thomas A. Beaton  
Reg. No. 46,543  
Attorney for Applicants

Date: 1/23/08

COVIDIEN  
60 Middletown Avenue  
North Haven, CT 06473  
(303) 581-6831